

## **REMARKS**

The Office Action mailed August 24, 2006 considered claims 1-31, 35, and 36. Claims 1-7, 11-18, 21-29, 31 and 35-36, were rejected under 35 U.S.C. 103(a) as being unpatentable over *Anderson et al.* (US 2002/0194307) hereinafter *Anderson* in view of *Oppenheimer et al.* (US 2003/001447) hereinafter *Oppenheimer* in view of *Eldridge et al.* (US 6,487,189) hereinafter *Eldridge*. Claims 8, 9, 10, 19, 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Anderson* in view of *Oppenheimer* in view of *Eldridge* and further in view of *LaRue et al.* (US 6,535,892) hereinafter *LaRue*.<sup>1</sup>

By this paper claims 1, 11, 21 and 35 have been amended and claims 23 - 31 have been cancelled. Claims 1-22, 35 and 36 remain pending in the application of which claims 1, 11, 21, and 35 are the only independent claims of the application.

Claims 1 and 21 are method claims, which claim embodiments of applicants' invention from a client-side perspective. Claims 11 and 35 are computer program product claims which correspond to method claims 1 and 21 respectively.

As presented herein for reconsideration, Applicants' claimed method and computer program product are adapted for use in a network environment that includes a client that is network connectable over a wireless network to a server so that the client may transmit document-inclusion operations that are intended to be carried out by the server, but wherein the wireless network may have limited throughput such that data transfer for document-inclusion operations may be unduly slow or costly. Applicants' claimed method and computer program product are designed to reduce those instances when the document-inclusion operation transmitted to the server actually requires transmission of a document that is required by the server to complete the requested operation, thereby reducing instances of unduly slow or costly data transmission when performing such document-inclusion operations over a wireless network.

Each of the independent claims now recites "displaying to a user at the client an indication that the document is attached to a message *even when the document is not attached to the message* and in response to user input received at the client instructing a document stored at the client to be attached to the message *such that whether or not the document is actually*

---

<sup>1</sup> Although the prior art status of the cited art is not being challenged at this time, Applicant reserves the right to challenge the prior art status of the cited art at any appropriate time, should it arise. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status of the cited art.

*attached is transparent to the user*<sup>2</sup>. The art cited in the present office action does not show these limitations.

Illustratively, *Anderson* discloses a number of embodiments. In one embodiment, a user sends an email with a document actually attached. See *Anderson* at [0030]. In an alternate embodiment, *Anderson* illustrates when a mobile device does not have a document to attach, the mobile device can request the document. See *Anderson* at [0036]. The document can either be returned to the mobile device (see [0038]) and/or returned to a printer (see[0040]). However, *Anderson* does not teach displaying to a user at the client an indication that the document is attached to a message even when the document is not attached to the message.

*Oppenheimer* does not compensate for the deficiencies of *Anderson*. In particular *Oppenheimer* does not address indications that a document is attached , but rather is directed to storing copies of files on servers. See [0045]. In particular, *Oppenheimer* shows uploading files from to a server if an identical version of the file is not already on the server.

Finally, *Eldridge* does not compensate for the deficiencies of *Anderson* and *Oppenheimer*. *Eldridge* is directed to transmitting document references or tokens. The references or tokens can be used with a token enabled server to facilitate sending documents. Abstract. However, *Eldridge* does not disclose "displaying to a user at the client an indication that the document is attached to a message even when the document is not attached to the message ...such that whether or not the document is actually attached is transparent to the user. Rather, *Eldridge* shown that a clear distinction is made as to whether a document is actually attached or whether only a token identifying the document is attached. For example, Figure 8 illustrates an indicator 802 which illustrates that the actual document is emailed, while the indicator 803 is used to illustrate when only a token is emailed. See also column 8, lines 47-65 which clearly describes a user selecting to either email an actual document or just a token. Thus, *Eldridge* fails to teach at least "displaying to a user at the client an indication that the document is attached to a message even when the document is not attached to the message ...such that whether or not the document is actually attached is transparent to the user.

In view of the foregoing, Applicants respectfully submit that the other rejections to the claims are now moot and do not, therefore, need to be addressed individually at this time. It will

---

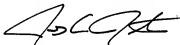
<sup>2</sup> Support for the amendments can be found throughout the specification, but with particularity at paragraph [0047] on page 16.

be appreciated, however, that this should not be construed as Applicants acquiescing to any of the purported teachings or assertions made in the last action regarding the cited art or the pending application, including any official notice. Instead, Applicants reserve the right to challenge any of the purported teachings or assertions made in the last action at any appropriate time in the future, should the need arise. Furthermore, to the extent that the Examiner has relied on any Official Notice, explicitly or implicitly, Applicants specifically request that the Examiner provide references supporting the teachings officially noticed, as well as the required motivation or suggestion to combine the relied upon notice with the other art of record.

In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 24<sup>th</sup> day of November, 2006.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'R. D. Nydegger', with a stylized flourish at the end.

RICK D. NYDEGGER  
Registration No. 28,651  
JENS C. JENKINS  
Registration No. 44,803  
J. LAVAR OLDHAM  
Registration No. 53,409  
Attorneys for Applicant  
Customer No. 047973